Supreme Court, U.S.
FILED
MAY 24 1996
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No. 95-1900

IN THE

Supreme Court of the United States

OCTOBER TERM, 1995

EXXON CHEMICAL PATENTS, INC., EXXON CORPORATION, and EXXON RESEARCH AND ENGINEERING CO.,

Petitioners,

v.

THE LUBRIZOL CORPORATION,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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RESPONDENT'S BRIEF IN OPPOSITION

At issue in this case is principally whether the Court of Appeals for the Federal Circuit properly construed the claims of a single patent, U.S. Patent No. 4,867,890 (the '890 patent), in light of its specific language and Patent Office prosecution history. Having exercised its authority to construe patent claims, under its decision in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (*in banc*), *aff'd*, 116 S. Ct. 1384 (1996), the Court of Appeals went on to conclude that no reasonable jury could find that Lubrizol's accused products infringed the '890 patent as properly construed, and ordered judgment as a matter of law for Lubrizol. In the light of this Court's affirmance in *Markman*, this case presents no issue warranting this Court's review.

STATEMENT

The background of this case is as follows:

1. The Lubricant Additive Industry

Lubrizol[1] and Exxon[2] are competitors and two of the leading manufacturers of lubricating oil additive compositions — packages of additives that, when combined with basestock, produce lubricating oil compositions for gasoline and diesel engines. Oil by itself (the "basestock") is not an adequate lubricant for these engines; only when the oil is combined with these additive packages can a motor oil meet modern performance standards. Typically, these additive packages include a dispersant (which functions to keep impurities suspended in the oil), an antioxidant (to prevent oxidation and inhibit engine wear), and a detergent

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[1] Pursuant to Supreme Court Rule 29.6, Respondent The Lubrizol Corporation states that it has no parent companies or nonwholly owned subsidiaries.

[2] Petitioners, plaintiffs-appellees below, are Exxon Chemical Patents, Inc., Exxon Corporation, and Exxon Research and Engineering, Co. For purposes of this brief, we refer to the three petitioners collectively as "Exxon."

(which helps to prevent engine deposits). This case involves a component of such an additive package — specifically, the use of specified, very small amounts of added oil-soluble copper as a supplemental antioxidant.

2. The '890 Patent

The question at the heart of this case was whether the particular patent in question should be construed as claiming a "recipe" of starting ingredients or as describing the combined components of the product. As discussed below, either approach is permissible as a matter of law, although whichever approach is elected must accurately describe the claimed invention. *See, e.g.*, 3 A.W. Deller, *Patent Claims* § 469, at 67-68 (2d ed. 1971) (discussing *Ex parte Greenbaum*, 38 U.S.P.Q. 350 (Bd. Pat. App. 1938)).

The title of the '890 patent shows that Exxon claimed "Lubricating Oil Compositions Containing Ashless Dispersant, [ZDDP],[3] Metal Detergent and a Copper Compound." Pet. App. 7a. The claims of the '890 patent which were at issue in this case are directed to "'[a] lubricating oil composition suitable as a crankcase lubricant in internal combustion engines comprising' (1) a major amount of lubricating oil, (2) an ashless dispersant (*i.e.*, one that neither contains nor is complexed with metal) in specified amounts of 'about 1 to 10 wt. %', (3) from about 0.01 to 5.0 parts by weight of oil soluble ZDDP, (4) 5 to 500 parts per million by weight of added copper in the form of an oil soluble copper compound, and (5) magnesium or calcium detergent." Pet. App. 5a-6a. The patent's specification includes over twenty references to the composition as "containing" these components, Pet. App. 8a; the patent claims themselves refer to the copper component as "added copper," and to the detergent as an "additive." Pet. App. 8a. The claim does not describe the invention in terms of its "ingredients," and indeed, nowhere in

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[3] ZDDP stands for zinc dihydrocarbyl dithiophosphate, "a zinc-containing compound that inhibits engine wear and produces antioxidant results for the oil." Pet. App. 4a, 19a.

the patent claims does the term "ingredient" appear, much less the term "starting ingredient."

It took over nine years, from initial application to issuance, for Exxon to secure the '890 patent. In the course of that prosecution, which became public only after the patent issued, Exxon had to overcome several prior art references which had already recognized that copper had value as an antioxidant. Initially, Exxon's claims were rejected as obvious in light of prior art (*see* 35 U.S.C. § 103), over three prior art U.S. patents which disclosed lubricating oil compositions. C.A. App. A2646-50, A2733-37, A2740-82.[4]

Exxon's second application, filed in 1982, was again rejected by the patent examiner, who concluded that the inventors "ha[d] reduced oxidation of an oil by adding known copper containing oxidation inhibiting compounds in small amounts. What could be more obvious!" C.A. App. A3079. Exxon appealed this rejection to the Board of Patent Appeals, but the Board affirmed the rejection, stating that "[f]ive of the eight [prior art] references cited teach precisely that which appellants deny, *i.e.*, the use of certain amounts of copper within the limitations recited in appellants' claims is a 'good idea,' but the use of larger amounts is a 'bad idea.'" C.A. App. A3249.

Exxon's third application, filed in 1986, was also rejected as obvious, in view of the same prior art patents which compelled rejection of Exxon's first application. C.A. App. A3487-90.

Exxon's fourth application, filed in 1987, was again rejected as obvious in light of the same prior art patents. Exxon, however, made a significant new argument: Instead of merely arguing that the use of copper as an antioxidant was patentable, Exxon argued that its composition was patentable because the combination of copper "with ZDDP in the presence of an ashless dispersant"

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[4] References to "C.A. App. ___" refer to the Joint Appendix filed in the Court of Appeals in No. 93-1275, which was Lubrizol's appeal from the liability judgment.

showed a "synergistic effect"; *i.e.*, that the components had a superior antioxidant effect when combined together. C.A. App. A3766-70; Pet. App. 8a. The application was still rejected by the Patent Office, as *both* obvious over the previously cited prior art patents, *and* anticipated by a newly cited Lubrizol patent issued to LeSuer, U.S. Patent 3,346,493. The examiner said that LeSuer disclosed the same components as did Exxon's application. C.A. App. A4150-54.

Exxon then submitted the results of comparative engine tests on its lubricating oil compositions, arguing, *inter alia*, that its compositions were different from and superior to the compositions disclosed in the LeSuer patent because Exxon's compositions purportedly showed unexpected benefits — specifically, the enhanced ability of the Exxon composition to avoid sludge and varnish deposits in the engine. These tests supposedly showed the "superior" performance of the Exxon composition as compared to the LeSuer composition. *E.g.*, C.A. App. A4188-94. Exxon contended that, compared to the Exxon compositions, the LeSuer compositions showed inferior results in engine tests because of the effect of the combination of copper with the dispersant in those compositions, whereas in the Exxon formulation the dispersant remained "ashless" (not complexed with metal) in the composition.[5] In other words, Exxon was urging novelty and patentability based upon the nature of the components in the composition as combined together. Two months after the submission of these comparative engine tests, the rejections were withdrawn and the claims were allowed by the Patent Office.

The '890 patent ultimately issued on September 19, 1989, the same day that Exxon filed suit against Lubrizol.

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[5] Exxon stated that this was so "presumably because of the inadequate dispersancy provided by the non-ashless copper complexed dispersant, in which (unlike the present invention) the copper interferes with the performance of the dispersant." C.A. App. A4193.

3. The Trial

A principal dispute at trial involved the proper construction of the '890 patent claims. Exxon urged that its patent was directed to a "recipe" for making the claimed lubricating oil composition; *i.e.*, "a composition defined by the ingredients that go into the composition." Exxon C.A. Brief at 22. Lubrizol, by contrast, argued that the claim language, specification, and prosecution history of the '890 patent all compelled the conclusion that the claims of that patent were drawn to the lubricating oil composition defined by its components as combined together (this was referred to by the parties below as the "in-the-pot" construction).

The distinction between the "recipe" construction urged by Exxon and the "in-the-pot" construction urged by Lubrizol was important, because, as a matter of chemistry, the starting ingredients do not remain static once they are combined. As a part of the blending of the components, the ashless dispersant which was used as a starting ingredient in Lubrizol's products reacted immediately and inevitably (as a matter of chemistry) with the ZDDP used as a starting ingredient. This formed a dispersant-ZDDP complex, which was not "ashless" (just as in LeSuer) because it contained zinc, a metal — in stark contrast to the ashless dispersant in the combined composition that Exxon claimed was patentable. C.A. App. A889; A1263-64; A1555; A1906; *see* Pet. App. 11a. Thus, while Lubrizol's accused lubricating oil compositions began with an ashless dispersant as a starting ingredient, the reaction of the components caused the dispersant, once combined, to be non-ashless, *i.e.*, complexed with metal. Lubrizol maintained that, if the "in-the-pot" construction were adopted by the district court, its products could not infringe because they lacked the claimed quantities of ashless dispersant ("1 to 10 wt. %") required by the claims.

At the close of Exxon's evidence, Lubrizol moved for a directed verdict, maintaining that under the "in-the-pot" construction of the '890 claims, no reasonable jury could find infringement because there was no proof that Lubrizol's accused compositions contained the required "1 to 10% wt. %" ashless

dispersant. The district judge denied the motion. Pet. App. 7a. Lubrizol renewed this motion at the close of all of the evidence; the district judge also denied that renewed motion. Pet. App. 7a.

The issue of claim construction was joined vigorously at the charge conference. After hearing extensive legal arguments from both sides (C.A. App. A1966-A2002), the district judge opted for the "recipe" claim construction proposed by Exxon. Although the district judge confessed during these arguments that "I still don't understand what the difference is between a recipe [claim] and a composition" (C.A. App. A1988), he suggested that he would "fall back on some judging techniques" and give the charge proposed by the party with "the strong burden of proof" — here, Exxon. C.A. App. A1987. Having been given that charge, the jury found, *inter alia,* that Lubrizol's products infringed the '890 patent as construed by the court.[6]

Lubrizol then moved, pursuant to Fed. R. Civ. P. 50(b), for judgment as a matter of law (JMOL). Pet. App. 7a. In that motion, Lubrizol once again asserted, *inter alia,* the argument that under the proper "in-the-pot" construction of the '890 patent's claims, no jury could find that Lubrizol's products infringed the '890 patent, because Exxon had failed to prove that Lubrizol's products contained *any* ashless dispersant, let alone the 1 to 10 wt. % required by the patent claims. Again, the district court denied Lubrizol's motion.

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[6] The same jury also found that the '890 patent was not invalid, was enforceable, and had been willfully infringed; that jury did not assess damages, however. From the judgment entered on that verdict, Lubrizol appealed to the Court of Appeals for the Federal Circuit (No. 93-1275). *See* 28 U.S.C. § 1295(a)(1) (in patent infringement suits, appeals to the Federal Circuit may be taken from judgments which are final except for an accounting of damages). While that appeal was pending before the Court of Appeals, the district judge held a second trial on damages. The judgment entered on the second jury's verdict was the subject of a second appeal (No. 94-1309), which was briefed and argued separately, but before the same panel. That panel consolidated the two appeals on its own motion. Pet. App. 4a n.2.

4. The Appeal

Lubrizol appealed the liability judgment to the Court of Appeals for the Federal Circuit. Lubrizol renewed the noninfringement arguments it had made to the district court, urging that "the court's denial of Lubrizol's Rule 50(b) motion for judgment as a matter of law should be reversed." Lubrizol C.A. Brief at 18. Lubrizol also raised several other grounds for reversal.

The Court of Appeals agreed with Lubrizol on the issue of claim construction, adopted what it called a "slight variance" of Lubrizol's proffered claim construction, reversed the judgment of infringement as a matter of law, and ordered judgment for Lubrizol "without remand for a second trial." Pet. App. 14a-15a. The perceived "slight variance" in claim construction resulted from the Court of Appeals' view that Lubrizol had only focused upon the end product composition, while the Court of Appeals' construction more broadly focused, without "temporal limitation," on any moment "once [the] ingredients are mixed." Pet. App. 9a. In view of its "reversal without remand for a second trial," the Court of Appeals did not address the several other issues raised by Lubrizol's appeal.

The Court of Appeals began by construing claims 1 and 61 of the '890 patent. Following its then-recent *in banc* decision in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), the Court of Appeals construed the claims *de novo*, as a matter of law. Pet. App. 5a. With careful detail, the Court of Appeals explained how "the claims, the specification, and the prosecution history all point to the conclusion that Exxon claims a product, not merely a recipe for making whatever product results from the use of the recipe ingredients." Pet. App. 8a. In view of its conclusion that the patent and its prosecution history were clear and unambiguous, the Court of Appeals did not rely on any of the disputed expert and other testimony presented at trial concerning how those witnesses might read the claims.

First, the Court of Appeals quoted the title of the '890 patent — "'Lubricating Oil Compositions *Containing* Ashless Dispersant,

[ZDDP], Metal Detergent and a Copper Compound'" — and explained that this title pointed the public to an understanding that the patent's claims covered a composition which contained the recited components, not a recipe for making that composition. Pet. App. 7a-8a (emphasis in original), *citing Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 780 (Fed. Cir. 1985) (explaining that the title given to a patent is a useful aid to interpreting the claims of that patent).

Second, the Court of Appeals parsed the language of the '890 patent claims and concluded that this language compelled a construction of the claims as directed to a combined lubricating oil composition, not, as the district court had charged, a "recipe." Claims 1 and 61 of the '890 patent claimed a "lubricating oil composition suitable as a crankcase lubricant in internal combustion engines"; plainly, as the Court of Appeals held, this language told the public that the claims covered a finished, combined composition "suitable" to be poured into an engine. Pet. App. 2a. By contrast, the separate ingredients, in their pre-combined states, were obviously not "suitable as a crankcase lubricant."[7]

Third, the Court of Appeals concluded that the specification of the '890 patent also supported its construction of the patent as covering a combined composition. For example, the specification made "over twenty references to 'containing' in reference to the ingredients claimed in the composition." Pet. App. 8a. This was confirmatory of the as-combined construction, for only a combined composition can "contai[n]" ingredients; had a so-called "recipe" construction of the claims been intended, the Court of

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[7] The Court of Appeals found other indicators in the claim language that the '890 patent claimed a combined composition and not a recipe — in particular, references to "added" copper and to a detergent "additive," which "aim at a chemical composition to which ingredients are being introduced," Pet. App. 8a, not to a recipe for making such a composition.

Appeals explained, one would not speak of that "recipe" as "containing" certain ingredients.

Fourth, the Court of Appeals reviewed the prosecution history of the '890 patent, and found that in prosecuting the '890 patent before the United States Patent and Trademark Office,

> Exxon repeatedly emphasized that the genius of its invention lay "in the *previously unknown* synergism of this material [copper] with ZDDP in the presence of an ashless dispersant of the type described in the application . . . ."

Pet. App. 8a (emphasis in original). "Synergism" between two or more materials, by definition, can exist *only* when the two materials are in the presence of each other — that is, when the materials are combined.

Based on these indicia — title, claims, specification, and prosecution history — all of which are part of the public record surrounding the '890 patent, the Court of Appeals concluded that claims 1 and 61 of that patent claimed not a recipe for the making of some unspecified product, but a composition product itself as defined by the specified components. Pet. App. 8a.

Having concluded that the claim construction adopted by the district court was erroneous, the Court of Appeals was left with but one question: "whether any jury could reasonably have found that Lubrizol's accused products literally infringe the claims of the '890 patent as properly construed." Pet. App. 10a. The Court of Appeals concluded that no reasonable jury could so find, because of the absence of proof that Lubrizol's composition *at any time after combination* contained the required "1 to 10 wt. %" ashless dispersant, and ordered judgment for Lubrizol. Pet. App. 12a-13a.

The Court of Appeals explained that, in attempting to prove its case under the "in-the-pot" construction of the claims advanced by Lubrizol, Exxon introduced evidence that, when the ingredients were combined, the bond between the zinc and the dispersant was a "weak," "unstable" one. Pet. App. 11a.

According to Exxon, because of the nature of this chemical bond, "the weak bond — with its constant reversal and rebonding — proved that Lubrizol's dispersant was not always nonashless, and therefore sometimes ashless." Pet. App. 11a-12a. The Court of Appeals accepted this testimony at face value, assuming that a jury "could reasonably have concluded that — at some time — during the manufacture of the product or in its manufactured state — ashless dispersant is found in Lubrizol's product." Pet. App. 12a.

But even so, according to the Court of Appeals, Exxon's trial proof had totally failed in showing "that Lubrizol's products contain ashless dispersant in the specific amounts claimed" — *i.e.*, "1 to 10 wt. %." Pet. App. 13a, 19a. Thus, applying precedents from both this Court (*Boyle v. United Technologies Corp.*, 487 U.S. 500 (1988)) as well as the Federal Circuit,[8] the Court of Appeals concluded that reversal without remand was proper. Pet. App. 10a, 14a-17a.

Judge Plager, who joined the majority opinion, also filed a brief concurring opinion. Pet. App. 21a. Judge Plager highlighted the fact that Exxon's trial theory of claim construction differed from the claims as they had been-written and prosecuted. As he explained, the definiteness required of patent claims cannot tolerate such malleability:

> . . . Claim drafting is itself an art, an art on which the entire patent system today depends. The language through which claims are expressed is not a nose of wax to be pushed and shoved into a form that pleases and that produces a particular result a court may desire. The public generally, and in particular, the patentee's competitors, are entitled to clear and specific notice of what the inventor claims as his invention . . . . There is no room in patent claim interpretation for the . . .

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[8] *Jamesbury Corp. v. Litton Indus. Prods.*, 756 F.2d 1556 (Fed. Cir. 1985); *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533 (Fed. Cir. 1991); *Dana Corp. v. IPC Ltd. Partnership*, 860 F.2d 415 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1067 (1989).

> equivalent of the *cy pres* doctrine; that would leave the claiming process too indefinite to serve the purposes which lie at the heart of the patent system.

Pet. App. 21a. Although the majority had announced no general rules of claim construction, Judge Nies dissented on the claim construction issue, urging that the majority had "mandate[d] technical rules for how chemical compositions must be claimed." Pet. App. 23a. Judge Nies also dissented on the decision to order judgment for Lubrizol rather than to order a new trial. Pet. App. 33a-37a.

Petitioners moved for rehearing and suggested rehearing *in banc*, urging essentially two grounds for rehearing. (A copy of that petition is attached to this brief in opposition.) *First*, petitioners claimed that the panel, even though it had relied extensively on the Court of Appeals' recent *in banc* decision in *Markman*, had in fact "misapplied" that decision by failing to consider extrinsic evidence that had been presented at trial, and by failing to give deference to the district court's adoption of Exxon's proffered claim construction. *Second*, petitioners claimed that the panel erred by refusing to order a new trial for Exxon. Exxon barely mentioned its present claim (Pet. 17-19) that the Court of Appeals' decision had announced a broad rule of claim construction that would adversely affect other patents with similar claim language. *See generally* Exxon's Petition for Rehearing and Suggestion of Rehearing *In Banc* (hereinafter "Petition for Rehearing") (attached).

The Court of Appeals denied rehearing, and declined the suggestion of rehearing *in banc*, one judge dissenting. Pet. App. 68a. Concurring in the denial of rehearing *in banc*, Judge Mayer reurged his opposition to the Court of Appeals' now-affirmed *in banc* decision in *Markman v. Westview Instruments, Inc.* Pet. App. 70a. Dissenting, Judge Newman argued that the panel decision had created "a new and incorrect rule of claim construction" that would invalidate a large number of "recipe" patents (Pet. App. 72a), even though Exxon had made no such argument in its petition for rehearing; Judge Newman also

disagreed with the panel's decision to order judgment for Lubrizol.

The panel majority (Judge Clevenger, joined by Judge Plager) also issued a brief concurring statement, making clear that Judge Newman's concerns were unfounded. The panel majority reiterated that its decision announced no general rule of law and that if the claim here had been properly drafted and prosecuted as a "recipe," it would have been interpreted as such. The majority thus explained that "Judge Newman's general views on how to read the claims in suit" had little relevance to the claims as they were actually drafted and prosecuted. Pet. App. 70a. The panel majority also explained that, contrary to the views advanced by Judge Newman, and by Exxon in its rehearing petition, "[t]he basic claim interpretation theory adopted by the court was put forth by Lubrizol in its defense to Exxon's suit." Pet. App. 71a.

5. Recent Events

After the mandate of the Court of Appeals issued, petitioners, on March 15, 1996, moved the district court for a new trial on infringement under a doctrine-of-equivalents theory,[9] a theory which it had abandoned at the first trial before the jury was charged. *See* Pet. App. 2a n.1. Lubrizol responded to that motion for new trial, urging that this issue had not been raised on appeal and that further proceedings in the district court have been foreclosed by the Court of Appeals' decision to order "judgment of noninfringement as a matter of law." Pet. App. 17a. Lubrizol also asked the district court to rule immediately. Petitioners, however, have urged the district court to hold their motion for a new trial pending the disposition of their petition for certiorari. The district court has taken no action on that motion to date.

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[9] The doctrine of equivalents allows a court to find infringement in cases where the literal language of a claim is not satisfied, but where literal infringement is avoided by "'a noncritical change.'" *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384, 1388 (1996) (quoting H. Schwartz, *Patent Law and Practice* 82 (2d ed. 1995)).

REASONS FOR DENYING THE WRIT

Petitioners have shown no basis for review. This Court's recent decision in *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384 (1996), confirmed that the construction of patent claims is a question of law, for the courts, in all cases. The Court of Appeals, applying its now-affirmed decision in *Markman*, 52 F.3d 967 (Fed. Cir. 1995) (*in banc*), *aff'd*, 116 S. Ct. 1384 (1996), faithfully applied that decision in arriving at a proper construction of the '890 patent's claims. The decision to order judgment as a matter of law for respondent necessarily and properly followed. Neither the interpretation of the particular claim language and prosecution history here, nor the decision on this record to order judgment as a matter of law, presents an issue worthy of this Court's consideration.

I. THE FEDERAL CIRCUIT'S CONSTRUCTION OF CLAIMS 1 AND 61 OF THE '890 PATENT DOES NOT MERIT THIS COURT'S REVIEW

Petitioners argue (Pet. (i)) that the Court of Appeals' opinion adopted a black-letter rule that "patents for chemical composition products cannot be claimed solely by identifying the ingredients used to make the composition." Relying on cases and other authorities which they did not even bother to cite in their Petition for Rehearing, petitioners urge that the Court of Appeals "Undermine[d] Established Law . . . That Allows Composition Of Matter Products To Be Claimed Solely By Listing Ingredients." Pet. 11.

To begin with, petitioners are wrong to urge that a claim-construction rule of general application was adopted in this case. It is quite apparent on the face of the court's opinion that no such rule was adopted or applied here. Instead, what the Court of Appeals held was that two particular claims (1 and 61) of a particular patent, as properly construed in light of the claim language, specification, and prosecution history, claimed a lubricating oil composition defined by the chemical components present "in the pot," *i.e.*, once the starting ingredients are combined. It is significant that, to date, this almost nine-month-

old decision has not been cited or applied in any other case decided by the Federal Circuit or, for that matter, by any other federal court.

While it is certainly true, as petitioners and Judge Newman say, that chemical compositions *may* be claimed by their starting ingredients, Pet. 11-15; Pet. App. 74a-81a, that is by no means the *only* way to write such a patent claim. Nor do we understand petitioners to claim the contrary, as is apparent from the Questions Presented.[10] Moreover, the authorities on which they rely do not establish that composition-of-matter claims *must* be drafted and interpreted as "recipe" claims. These authorities recognize only that a composition of matter invention *may* be claimed by description of the starting ingredients.

For example, petitioners imply that in *Holland Furniture Co. v. Perkins Glue Co.*, 277 U.S. 245 (1928), this Court held that a composition patent *must* be claimed by reference to its starting ingredients, but petitioners do so only by means of a cropped and incomplete quotation from that case. The Court's actual language, in full, made clear that this statement was patent-specific: "*It was necessary that the Perkins* patent, so far as it is a patent of a composition of matter, should contain some description of ingredients entering into the composition which would both define the invention . . . and carry it beyond previous development of the art." *Id.* at 254 (omitted material italicized). Reference to starting ingredients was necessary there because, as the Court noted immediately thereafter, "[h]ad Perkins claimed only a glue made of starch dissolved in three parts of water with an alkali [*i.e.*, the final product], he would not have advanced beyond the Gerard and Dornemann patents and subsequent practice." *Id.* This Court has never interpreted *Holland*

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[10] The first question presented is "Whether the court of appeals erred in holding, contrary to the law upon which many thousands of patents are based, that patents for chemical composition products cannot be claimed solely by identifying the ingredients used to make the composition?" Pet. (i).

Furniture as mandating starting-ingredients descriptions of all composition claims.[11]

The *Holland Furniture* invention was a wood and fiber glue product, produced with known processes (277 U.S. at 247-48, 251-52), where patentability derived from the use of a specific starch as a starting ingredient. *Id.* at 255. The Court invalidated claims 28, 30 and 31 because they recited the use or function of the glue, instead of identifying a structure related to the specific starch of the invention. This improperly broadened the claims beyond the invention actually made. *Id.* at 256-58. The Court appeared to recognize that the finished product claims could have described the specific starting ingredient "in terms of its own physical characteristics or chemical properties *or those of the [finished] products.*" *Id.* at 256 (emphasis added). This belies any suggestion that a "recipe" claim form for all compositions is required.

So, too, none of the other cases on which petitioners rely suggests that a composition-of-matter invention must be claimed by reference to the starting ingredients.[12] And other authorities

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[11] Similarly, the other quotation from *Holland Furniture* on which petitioners rely (Pet. 12), in context, does not suggest that all composition patents must be claimed by the description of starting ingredients. The Court stated: "But here we are concerned only with the choice of one ingredient of the product. There can be no description of a composition of matter without some designation of its ingredients." 277 U.S. at 255.

[12] These cases (Pet. 13 & n.7, 15 n.10) generally involved compositions which *were* claimed by their starting ingredients, and construed patents with claim language quite different from the language present in the '890 patent. Several of the cited cases involve patents claiming "a mixture" or "an admixture," language which may properly be used to claim a composition defined by its starting ingredients — but which was *not* used in the claims of the '890 patent. *Application of Henderson*, 348 F.2d 550, 550 (C.C.P.A. 1965) ("a mixture"); *American Chemical Paint Co. v. Firestone Steel Prods. Co.*, 117 F.2d 927, 930 (6th Cir. 1941) ("a

recognize that a combined-components claim may also be appropriate. *See, e.g.*, 2 W. Robinson, *The Law of Patents for Useful Inventions* § 532, at 148 (1890) (a composition-of-matter claim may be drafted "by enumerating its elements, and stating the mode of their union, and the essential qualities of the resulting composition. If such a Claim cannot be framed, whatever defines and distinguishes the composition from all others will suffice — as where it describes the compound as the result of mixing certain ingredients in a certain manner.") (footnote omitted); 3 Deller § 469, at 67-68.[13]

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pickling bath for metal comprising an admixture of water, acid and a thiocyanate"); *American Purifyne Co. v. Novadel Process Corp.*, 3 U.S.P.Q. 180, 182 (2d Cir. 1929) (claiming a "mixture" of the stated ingredients); *Panzl v. Battle Island Paper & Pulp Co.*, 132 F. 607 (N.D.N.Y. 1904), *aff'd in part, rev'd in part*, 138 F. 48, 53 (2d Cir. 1905) (patent interpreted as claiming "mixture and its [starting] proportions"). So too, the patent in *Chadeloid Chem. Co. v. Frank S. DeRonde Co.*, 146 F. 988 (C.C.S.D.N.Y. 1906), claimed both a paint-removing composition and a process for making that composition; the process claims made quite clear that the components described were starting ingredients. *Id.* at 988-89. And *Application of Lindner*, 457 F.2d 506 (C.C.P.A. 1972), is at best unclear as to whether a "recipe" of starting ingredients construction was adopted, or whether there was any difference in the components before and after they were combined.

[13] In *Ex parte Greenbaum*, 38 U.S.P.Q. 350 (Bd. Pat. App. 1938), discussed at length in a leading treatise cited in Judge Newman's dissent (*see* 3 A.W. Deller, *Patent Claims* § 469, at 67-68 (2d ed. 1971)), the applicant drafted a claim for "An ointment containing stearic acid, triethanolamine, and allantonin particles . . . ." The first two components, when mixed together, did not stay static but, rather, "form[ed] an amine soap." *Id.* at 350, 351. The patent examiner thus rejected as "inaccurate" the applicant's composition claim for an "ointment containing" the three components, since the claimed ointment did not in fact "contai[n]" them. *Id.* at 351. The Board of Patent Appeals, however, allowed the claims to be redrafted to claim "the reaction product of" the three components (*id.*), which is recognized as an appropriate way to draft a "recipe" claim. 3 Deller § 469.

The sole, narrow question in this case was whether the '890 patent defined the invention in terms of "starting ingredients" or by reference to what the final composition contained. The patent repeatedly described the invention in terms of what it "contained," and, significantly — and contrary to the implication which the Petition seeks to convey by its extensive discussion of the word "ingredient" (Pet. 11-15) — the '890 patent claims *never* used the term "ingredient," much less the term "starting ingredient."[14]

The Court of Appeals thus did not hold that a patent claim can never be written as a "recipe"; it simply held that Exxon's claims were not so drafted. If the claims had been drafted as "recipe" claims, they would have been enforced as such. Pet. App. 70a. Indeed, as the Court of Appeals explained, its decision was compelled by "the flaws in [Exxon's] claim drafting . . . and trial strategy" (Pet. App. 15a), not by any broadly applicable rules.

The prosecution history of the '890 patent, which the Court of Appeals also relied on, yet is barely mentioned in the Petition, confirms the case-specific nature of the holding below. That prosecution history shows that Exxon succeeded in securing a patent, after years of fruitless effort, only when it abandoned its unsuccessful efforts to claim a "recipe" and instead purported to demonstrate that the ingredients *when combined* had a

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[14] The Federal Circuit's decision used the term "ingredients" to refer both to the ingredients used at the start of the process, as well as those appearing in the composition as combined. *See, e.g.*, Pet. App. 7a ("Whether the specified *ingredients* could be found in the actual composition produced by mixing the *ingredients* is, according to Exxon, simply irrelevant to the meaning of the claims.") (emphasis added). This usage is, of course, fully consistent with standard dictionary definitions of "ingredient." *Webster's Third New Int'l Dictionary* 1162 (1986) ("something that enters into a compound or is a component part of any combination or mixture"). And while the specification of the '890 patent does refer, in one instance, to "a.i.," or "active ingredient," that term in context means a concentration of chemical in oil; it is not used in the sense petitioners contend.

"synergis[tic]" effect because the dispersant *remained* ashless in the mixing pot — *i.e.*, not complexed with metal. Pet. App. 8a. This is thus not a case, such as that hypothesized by Judge Newman, where "[w]hatever interactions occur within the container holding the composition is irrelevant to the specificity and clarity of the claim and its understanding by persons in the field of the invention." Pet. App. 78a.

So too, Exxon's reliance upon Judge Nies' dissent from the original panel opinion clearly misconceives the claim language and prosecution history. She stated that "I interpret 'ashless dispersant' as simply the name or designation of an ingredient required as one of the additives. It does not mean the ingredient must remain inert." Pet. App. 23a. She similarly noted that "under [Exxon's] interpretation," "it does not matter what complex forms between metal and the dispersant." Pet. App. 25a. But the prosecution history is quite clear: Exxon succeeded in persuading the examiner that the claim was new only because it purported to show that the ashless dispersant remained ashless after the combination of ingredients. It *did* matter "what complex form[ed] between metal and the dispersant." Having prosecuted the '890 patent on this basis, petitioners cannot complain of the Court of Appeals' claim interpretation. "It is, of course, well settled" that claims are construed in light of their language, and "also with reference to the file wrapper or prosecution history in the Patent Office. *Hogg v. Emerson*, 11 How. 587 (1850); *Crawford v. Heysinger*, 123 U.S. 589 (1887)." *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966).[15]

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[15] Although Judge Nies argued that the prosecution history supported her claim construction (Pet. App. 28a-30a), the snippets of that history that she cited were arguments made by Exxon during prosecution of its first and second parent applications (S.N. 177,367 and S.N. 362,114), applications which were rejected by the Patent Office. Exxon later disavowed these arguments in its fourth and final application in order to gain allowance over the LeSuer patent. *See* Lubrizol C.A. Brief at 6-7; Lubrizol C.A. Reply Brief at 7-9.

Put simply, no claim-construction rule of general application was announced or applied in this case. In the face of this plain and clear reading of the Court of Appeals' opinion, petitioners' contention that the Court of Appeals adopted an unsound rule respecting all types of chemical composition claims is without merit. Such a claim-specific, case-specific issue does not warrant this Court's attention.

It is particularly significant that the issue concerning the language of the claims which petitioners now urge to be of paramount importance was barely mentioned — indeed, none of these cases was even cited — in its petition for rehearing in the Court of Appeals. There, the claim construction issue urged by petitioners was their contention that "The Panel Majority Misapplied . . . *Markman* When It Failed To Consider The Extrinsic Evidence . . . ."[16] Petitioners did not urge that the issue of how to construe the claim language with respect to extrinsic evidence was worthy of *in banc* review. Under those circumstances, review by this Court would be particularly inappropriate.

Even if the Federal Circuit had adopted a broadly applicable rule, as petitioners claim, this Court's review still would not be appropriate. The Court of Appeals for the Federal Circuit was chartered "as an exclusive appellate court for patent cases," *Markman,* 116 S. Ct. at 1396, and one of the principal reasons for concentrating patent appeals in a single court was to "provid[e] a new forum for the *definitive adjudication* of selected categories of cases," including, of course, patent cases. S. Rep. No. 275, 97th Cong., 1st Sess. 3 (1981) (emphasis added). If this supposed "rule" is as "incorrect" and "disruptive" as petitioners claim (Pet. 17), there is no reason to believe that the Federal Circuit — which routinely hears patent cases involving chemical compositions — will not in future cases explain this "rule," if

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[16] Plaintiffs-Appellees' Petition for Rehearing at 10, *Exxon Chemical Patents, Inc. v. The Lubrizol Corp.*, 64 F.3d 1553 (Fed. Cir. 1995) (Nos. 93-1275, 94-1309) (attached as an appendix to this brief).

necessary. Consistent with its Congressionally mandated role, it would be appropriate for the Federal Circuit to develop and apply this supposed "rule" of patent law by explicating it in future cases before this Court considered the issue.

II. THE FEDERAL CIRCUIT'S DECISION NOT TO RELY UPON TESTIMONY IN THE RECORD DOES NOT SHOW THAT A RULE OF GENERAL APPLICATION WAS ADOPTED

Petitioners urge (Pet. 15-17) that the Federal Circuit's failure to rely on record testimony shows that a rule of general application was adopted. This is not so.

Contrary to petitioners' argument (Pet. 15), no one "Skilled In The Art" gave testimony "Regarding Their Understanding Of The Patent." Most of the testimony on which petitioners rely was not given by persons "skilled in the art." Johmann, Exxon's patent counsel, gave testimony about "literally thousands of lubricant patents" (Pet. 6), but he did not testify about the claim language or prosecution history of the '890 patent. Moreover, as even the dissent noted (Pet. App. 31a), his was not testimony by "a scientist skilled in the art." C.A. App. A2206. And although petitioners, citing Judge Nies' dissent (Pet. 16 n.11), suggest that Mr. Pindar "read the claims as a person of skill in the art would read the claims" (Pet. App. 31a), there is no record support for that assertion. Mr. Pindar was an advisor to Lubrizol's legal division, not a formulator, and was never shown to be skilled in the art. His deposition was never taken and he did not testify at trial. C.A. App. A1834. And Lubrizol's Dr. Salomon, while she was skilled in the art, concededly gave no testimony "in the specific context of interpreting claim language." Pet. App. 31a (Nies, J., dissenting).[17]

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[17] Thus, petitioners' claim that the district court "agreed that 'there is no dispute how the formulators have read this patent'" (Pet. 15, *quoting* C.A. App. A1973) is inapposite — no formulators in fact testified as to how they read this patent.

Moreover, the inventors' testimony, while sometimes in conflict with itself, appeared to recognize that they had claimed the invention in terms of the final composition. Dr. Colclough admitted that claim 1 defines "all the components as blended together in the lubricant ready to go into the engine," and that claim 61 defines "a finished concentrate in the pot, everything all mixed together ready to be then mixed with a larger quantity of lubricating oil." C.A. App. A632-34. Dr. Marsh admitted that "Claim 1 says nothing about the individual components;" rather, "Claim 1 is all about an oil formulation," and "the invention is the final composition." C.A. App. A890. Exxon's counsel similarly understood Dr. Marsh's testimony: "What he is saying is that it is not what you start with that he is claiming, it is what you finish with." C.A. App. A890. The Exxon patent attorney who prosecuted the fourth and final application to allowance also admitted that the claims of '890 were drawn to "the materials as mixed together." C.A. App. A1064-65.

The Court of Appeals' decision not to rely on this testimony, in the face of the particular language of the patent and its unique prosecution history, in no way suggests that the Federal Circuit was establishing a rule of general application.

III. THE FEDERAL CIRCUIT'S DECISION TO ORDER JUDGMENT AS A MATTER OF LAW FOR RESPONDENT DID NOT INVOKE A SIGNIFICANT CHANGE IN CLAIM INTERPRETATION, WAS ENTIRELY PROPER, AND DOES NOT MERIT THIS COURT'S REVIEW

Petitioners' final argument for review (Pet. 19-24) is that the Court of Appeals erred by ordering judgment of noninfringement as a matter of law, instead of ordering a new trial in the district court. The Court of Appeals' decision in this regard was correct; it presents no ground for review.

This Court established in *Neely v. Martin K. Eby Construction Co.*, 386 U.S. 317 (1967), that the courts of appeals have the power and authority, "in appropriate cases," to order judgment n.o.v. without a new trial. *Id.* at 323, 326. *See also* 28 U.S.C.

§ 2106.[18] It would not, however, be an appropriate use of this Court's resources to grant review to the question of whether the Court of Appeals properly exercised the informed judgment conferred upon it by *Neely* in declining to order a new trial.

In the first place, petitioners' argument is ultimately dependent upon their theory that, because the Court of Appeals supposedly adopted a "Theory Never Advanced By Lubrizol" (Pet. 19), ordering judgment for Lubrizol was therefore inappropriate. As the Court of Appeals made clear in denying rehearing, that is not an accurate characterization of the decision below. The panel majority explained that there was no material difference between the Court of Appeals' claim construction and that urged by Lubrizol at trial: "The basic claim interpretation theory adopted by the court was put forth by Lubrizol in its defense to Exxon's suit." Pet. App. 71a. Thus, even if petitioners' arguments for review were otherwise meritorious (which, as we have shown, they are not), the major premise of their arguments is nonetheless absent.

Second, even if there had been a meaningful difference between the Court of Appeals' claim construction and that advanced by Lubrizol at trial, there could not have been any prejudice to petitioners, because, as the Court of Appeals held, petitioners' trial proofs and arguments had addressed the construction which the Court of Appeals adopted. Pet. App. 14a-15a, 15a n.6. And, further, even assuming (1) that the Court of Appeals *had* adopted a substantively different claim construction than that advanced by

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[18] Section 2106 of Title 28, United States Code, provides:

> The Supreme Court or any other court of appellate jurisdiction may affirm, modify, vacate, set aside or reverse any judgment, decree or order of a court lawfully brought before it for review, and *may* remand the cause and *direct the entry of such appropriate judgment, decree, or order,* or require such further proceedings to be had as may be just under the circumstances.

(Emphasis added.)

Lubrizol, and (2) that Exxon had not addressed it at trial, the Court of Appeals' decision to order judgment as a matter of law still would not conflict with the decisions of this or any other Court. Indeed, it is totally supported by this Court's decision in *Boyle v. United Technologies Corp.*, 487 U.S. 500 (1988).

In *Boyle*, which was relied upon by the Court of Appeals in this case (Pet. App. 10a), this Court held that post-trial motion practice requires (1) the ascertainment of the correct legal standard, and (2) determining, under that standard, whether "the evidence presented in the first trial would not suffice, as a matter of law, to support a jury verdict." 487 U.S. at 513. In *Boyle* (where the proper formulation of the "government contractor defense" was at issue), the defendant's Rule 50 motion articulated only one version of the defense — the unobjected-to version of that defense as it had been charged to the jury.[19] The Fourth Circuit on appeal, and ultimately this Court, endorsed a *different* version of the defense than the one contained in the jury instruction, yet this Court specifically rejected Boyle's claim for a new trial. There was no dispute, as this Court stated in *Boyle*, that "the formulation of the defense adopted by the Court of Appeals [and affirmed by this Court] differed from the instructions given by the District Court to the jury." 487 U.S. at 513. Yet no new trial was necessary. As this Court explained:

> If the evidence presented in the first trial would not suffice, as a matter of law, to support a jury verdict under the properly formulated defense, judgment could properly be entered for the

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[19] Petitioners attempted to claim, in the Court of Appeals, that the verdict-loser in *Boyle* had in fact anticipated the identical version of the defense as articulated by the Fourth Circuit and ultimately by this Court by arguing that legal standard in its JNOV papers. Lubrizol showed that this contention was demonstrably incorrect, by lodging a copy of defendant United Technologies' JNOV memorandum with the Court of Appeals. *See also* The Lubrizol Corporation's Opposition to Plaintiffs-Appellees' Motion for Leave to File Reply at 3-7 (Dec. 27, 1995) (explaining this point).

> respondent at once, without a new trial. And that is so even though (as petitioner claims) respondent failed to object to jury instructions that expressed the defense differently, and in a fashion that would support a verdict.

487 U.S. at 513-14.

Petitioners attempt to distinguish *Boyle* on the grounds that the *Boyle* decision "did not even cite Rule 50" (Pet. 23) and on the ground that "Boyle did not argue that JMOL may not be directed by an appellate court on legal theories that differ from the ones presented in the JMOL motions filed in the district court." Pet. 23. The first point is irrelevant; the second, inaccurate. Before this Court, Boyle (the petitioner, plaintiff and verdict-winner below) in fact argued the point urged here by petitioners: "If The Government Contractor Defense Is A Jury Question, The Court of Appeals Improperly Decided The Case On Law It Just Announced Without Remanding For A New Trial By Jury On The Facts Regarding The Just Announced Law." Petitioner's Brief at 32, *Boyle v. United Technologies Corp.*, 487 U.S. 500 (1988) (No. 86-492). It was exactly this position, the same position urged by petitioners here, that the Court rejected. While the petitioner in *Boyle* framed the argument in terms of the Seventh Amendment, it is difficult to believe that Rule 50 would compel a different result.

Like the Seventh Amendment itself, Rule 50 "approved explicitly" traditional practices for limiting the discretion of juries. *See, e.g., Galloway v. United States*, 319 U.S. 372, 389 (1943). Thus, Courts have not hesitated to consult Seventh Amendment standards in construing Rule 50, as petitioners' own authority makes clear. *See Sulmeyer v. Coca Cola Co.*, 51 F.2d 835, 846 & n.17 (5th Cir. 1975), *cert. denied*, 424 U.S. 934 (1976). *See also* Fed. R. Civ. P. 50 advisory committee notes, 1991 amendment (citing Seventh Amendment decisions). Indeed, Exxon itself conflated the two in its petition for rehearing, urging that "the majority violated Rule 50 and the Seventh Amendment jury-trial rights it protects." Petition for Rehearing at 4.

Moreover, this case would present an extraordinarily poor vehicle for determining whether, as petitioners suggest, Rule 50 somehow supersedes the Seventh Amendment holding of *Boyle*. First, petitioners did not raise below, in their petition for rehearing, their current claim that *Boyle* is inapplicable to Rule 50. Second, as noted above, respondent did advance the "basic" theory of claim interpretation ultimately adopted by the Federal Circuit. Pet. App. 71a. And third, petitioners did present testimony that addressed the Federal Circuit's theory. Pet. App. 14a-15a & n.6.

Finally, the cases on which petitioners do rely (Pet. 21-22) do not establish a conflict. These cases hold that a court of appeals cannot order JMOL where *no* Rule 50 motion was filed (*Wells Real Estate v. Greater Lowell Board of Realtors*, 850 F.2d 803, 810 (1st Cir.), *cert. denied*, 488 U.S. 955 (1988); *Hinojosa v. City of Terrell, Tex.*, 834 F.2d 1223, 1228 (5th Cir. 1988); *Quinn v. Southwest Wood Products, Inc.*, 597 F.2d 1018, 1024 (5th Cir. 1979)), that a party cannot raise a basis in a renewed motion for judgment as a matter of law that was not raised in the original motion (*Cone v. West Virginia Pulp & Paper Co.*, 330 U.S. 212, 217-18 (1946); *Johnson v. New York, N.H. & H R. Co.*, 344 U.S. 48 (1952); *Perdoni Bros., Inc. v. Concrete Systems, Inc.*, 35 F.3d 1, 3 (1st Cir. 1994); *Lambert v. Genesee Hospital*, 10 F.3d 46, 53-54 (2d Cir. 1993), *cert. denied*, 114 S. Ct. 1612 (1994); *Diercks v. Durham*, 959 F.2d 710, 714 (8th Cir. 1982); *Sulmeyer v. Coca Cola Co.*, 515 F.2d at 846), or that a court cannot grant a motion for JMOL on one claim when the movant sought JMOL only on another (*Murphy v. City of Long Beach*, 914 F.2d 183, 186 (9th Cir. 1990) (citing *Kutner Buick, Inc. v. American Motors Corp.*, 868 F.2d 614, 617 (3d Cir. 1989))). None of petitioners' cases contradicts *Boyle*.

CONCLUSION

For the foregoing reasons, the petition should be denied.

Respectfully submitted,

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May 24, 1996

APPENDIX

PETITION FOR REHEARING AND SUGGESTION FOR REHEARING IN BANC OF PLAINTIFFS-APPELLEES

IN THE

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

93-1275, 94-1309

EXXON CHEMICAL PATENTS, INC., EXXON CORPORATION, and EXXON RESEARCH AND ENGINEERING COMPANY,

Plaintiffs-Appellees.

v.

LUBRIZOL CORPORATION,

Defendant-Appellant.

Appeal From A Judgment Of The United States District Court For The Southern District Of Texas, Houston Division Norman W. Black, Chief United States District Judge

* * * *

I. OVERVIEW OF POINTS OF LAW AND FACT SUPPORTING *IN BANC* AND PANEL CONSIDERATION

For two independent and compelling reasons the decision of the panel majority in this case, from which Judge Nies dissented, should be reheard, affording the parties their first opportunity to brief and argue the issues raised herein:

First, without receiving any briefing or argument from the parties on the issue, the panel majority decided that it could *sua sponte* adopt a claim construction, advocated by neither party below nor subscribed to by any person skilled in the art, thereby declaring that Lubrizol is entitled to judgment as a matter of law and depriving Exxon of the opportunity to prove infringement at a new trial on the basis of the panel majority's construction of the claim. As we will show below, this disposition violates Fed. R. Civ. P. 50, and denies Exxon the right to a new trial in which a jury could consider evidence based upon what this Court has now declared to be the applicable law of the case.

Second, the panel majority has interpreted *Markman v. Westview Instruments Inc.*, 52 F.3d 967, 979, 34 USPQ2d 1321, 1329 (Fed. Cir. 1995), *cert. granted*, No. 95-26 (U.S. Sept. 27, 1995), as empowering this Court based only on the claims, specification, and prosecution history and "without deference to the trial judge" to construe the claims of Exxon's '890 patent. As a result, the panel majority ignored compelling extrinsic evidence relied upon by the trial court, as well as the requirement that claims be construed from the perspective of a person of ordinary skill in the art, and embraced, in the words of Judge Nies, "technical rules for how chemical compositions must be claimed," with ramifications extending far beyond the facts of this case (slip op. at 3).

The way in which these two errors by the panel majority deprived Exxon of a verdict — obtained in the face of findings below that Lubrizol deliberately copied and willfully infringed Exxon's pioneer invention and engaged in numerous incidents of "vexatious litigation, and bad faith," A3 (damages), A112 — standing alone, justifies rehearing. There are, however, matters at issue here that transcend this case, casting doubt upon both the "skilled in the art" perspective that has historically been the basis for claim construction and this Court's *in banc* decision in *Markman*, now pending before the Supreme Court on certiorari.

The violation of Exxon's Rule 50 and jury trial rights to prove infringement under the panel majority's newly-minted claim

construction is evidence of the unprecedented expansion of this Court's authority at the expense of district courts decried by those members of this Court who wrote separately in *Markman*. 52 F.3d at 993, 1006, 34 USPQ2d at 1341, 1352. And, the "*de novo* review" exercised by the panel majority here, disregarding the district judge's consideration of all of the extrinsic evidence, raises serious questions regarding the "skilled in the art" perspective for claim construction. It also can only fuel concerns for the future predicted by those who disagreed with *Markman*, calling into question that decision by underscoring issues of fundamental concern regarding the relationship between trial and appellate court authority.

Apart from the two issues discussed above, which merit *in banc* review, there are two clarifications that the panel will surely agree should be made in its opinion: First, the vacation of the attorneys' fee award assumed that it was based solely on 35 U.S.C. § 285 (prevailing party fee award). However, the award was also based on 28 U.S.C. § 1927 (vexatious litigation fee award) (A110-11, 118). *See* A112 (setting forth the district court's findings on this issue). As the district court held:

> Both the trial judge and the magistrate judge found that Lubrizol engaged in obstructive behavior prior to the liability trial. Counsel made unnecessary and lengthy objections and interjections during depositions and made so many excessive discovery requests that the cost and delay was substantial.

A4 (damages). Because § 1927 allows awards to non-prevailing parties, *Roadway Express, Inc. v. Piper*, 447 U.S. 752, 762 (1980); *Oliveri v. Thompson*, 803 F.2d 1265, 1273 (2d Cir. 1986), *cert. denied*, 480 U.S. 918 (1987), the panel should clarify that its vacation of Exxon's attorneys' fee award does not prevent the district court on remand from awarding some portion of those fees pursuant to § 1927. *See Westvaco Corp. v. International Paper Co.*, 991 F.2d 735, 746, 26 USPQ2d 1353, 1362 (Fed. Cir. 1993).

Second, the panel majority correctly noted that Exxon's entitlement to a jury trial on infringement based on the doctrine

of equivalents was neither briefed nor argued to the panel, and consequently was not decided by this Court. Slip op. at 1 n.1. Exxon is entitled to a new trial in the district court on that issue, which became moot — and accordingly was neither raised by the court's instructions nor argued by counsel to the jury — because it was undisputed that Lubrizol infringed under the district court's claim construction.[1] *See Weade v. Dichmann Wright & Pugh Inc.*, 337 U.S. 801, 808-09 (1949) (appellate court entry of JMOL improper where there were "suggestions in the complaint and evidence" of an alternative theory of liability not passed upon by the jury). Nothing in the Court's opinion purports to bar Exxon from moving for a new trial in the district court under the doctrine of equivalents. However, out of an abundance of caution, Exxon requests that the panel clarify its opinion in this regard.

II. THE PANEL MAJORITY HAS VIOLATED RULE 50 AND DEPRIVED EXXON OF ITS RIGHT TO SEEK A NEW TRIAL BEFORE A JURY

The panel majority's ruling rests on a claim interpretation that no one contemplated at trial. Rejecting Exxon's showing that the claims encompass any product made from the specified amounts of starting ingredients, as well as Lubrizol's contention that the claims pertain only to final products, the panel majority held that the claims encompass any product having the specified ingredients at any time after blending. Incorrectly asserting that Exxon introduced no evidence establishing the amount of ashless dispersant in Lubrizol's products at any time after mixing, the majority reversed the denial of Lubrizol's JMOL motion for noninfringement. Slip op. at 13-14. In so ruling, the majority

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[1] *See* Judge Nies's dissent, slip op. at 17 ("Exxon proposed deletion of an instruction on infringement by equivalents in the final version of the instructions, but this revision occurred only after the district court adopted Exxon's claim interpretation in its instructions. Exxon did not waive this issue in connection with Lubrizol's or the majority's different interpretation of the claim.").

violated Rule 50 and the Seventh Amendment jury-trial rights it protects.

The panel majority acknowledged that "Lubrizol's view of the claims is less generous to Exxon than ours." Slip op. at 17 n.5. Under this new, broader claim interpretation, Exxon should have the opportunity to demonstrate to the trial judge in a new trial motion that it can offer substantial evidence that Lubrizol's "intermediate" products infringe. For example, contrary to the panel majority's opinion, Exxon's evidence showed that two of Lubrizol's final products contained approximately .54 and .60 wt. percent of borated ashless dispersant (see attached PX703, 2404) (while the claimed amount of ashless dispersant is "about 1" wt. percent), and Lubrizol stated that such borated ashless dispersants do not complex with ZDDP and remain ashless after blending (Lz. Br. 10). Exxon would show that, upon a new trial, it could prove that Lubrizol's intermediate products contained similar amounts of borated ashless dispersant. Other such relevant evidence could include, among other things, the order of blending Lubrizol's ingredients, the duration, temperature, and pressure of blending, and the components present and the rate of addition of those components during blending. That evidence would have been irrelevant under the claim constructions asserted below.[2] The majority's apparent assumption — based on neither briefing nor argument — that Exxon cannot prove infringement under the new interpretation, *see* slip op. at 1 (Plager, J.,concurring) ("Exxon's burden . . . may be impossible of accomplishment"),

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[2] Contrary to the view of the majority, slip op. at 15, Exxon did not submit evidence directed to Lubrizol's "intermediate" products, but only to its final products. Specifically, to rebut Lubrizol's assertion that its final product did not contain ashless dispersant, Exxon introduced expert testimony that any chemical interactions between the ZDDP and ashless dispersant in Lubrizol's fully blended, final oil product were so weak and transitory that those components would be considered non-complexed. A1253-55.

is wrong and, moreover, raises matters that should be left to the trial judge.

In these circumstances, the district court should be permitted to exercise its discretion to determine whether to grant a new trial, because under the new claim construction the "defect" in Exxon's proof can be remedied on a second trial. Rule 50(d) "recognizes that the appellate court may prefer that the trial judge pass first" upon the new trial issue. *Neely v. Martin K. Eby Constr. Co.*, 386 U.S. 317, 323-24 (1967). But the Supreme Court emphasized, *id.* at 325, that the appellate court

> may not order judgment [as a matter of law] where . . . the record reveals a new trial issue which has not been resolved. Part of the Court's concern has been to protect the rights of the party whose jury verdict has been set aside on appeal and who may have valid grounds for a new trial, some or all of which should be passed upon by the district court, rather than the court of appeals, because of the trial judge's first-hand knowledge of witnesses, testimony, and issues — because of his "feel" for the overall case. These are very valid concerns to which the court of appeals should be constantly alert.

Furthermore, Rule 50(b) gives district courts discretion to order new trials, rather than grant judgment as a matter of law, if defects in the nonmoving party's proof might be remedied on a second trial. *See Cone v. West Virginia Pulp & Paper Co.*, 330 U.S. 212, 215-16 (1947). The "'[d]etermination of whether a new trial should be granted or judgment entered under Rule 50(b) calls for the judgment in the first instance of the judge who saw and heard the witnesses and has the feel of the *case which no appellate printed transcript can impart.*'" *Thurber Corp. v. Fairchild Motor Corp.*, 269 F.2d 841, 852 (5th Cir. 1959) (emphasis added) (quoting *Globe Liquor Co. v. San Roman*, 332 U.S. 571, 574 (1948)).

Rule 50 also protects parties from being blindsided by challenges to the sufficiency of the evidence made when they can no longer cure the alleged defect by presenting additional evidence. Rule 50(a)(2) provides that a pre-verdict motion for

JMOL "shall specify the judgment sought *and the law and the facts on which the moving party is entitled to the judgment.*" The rule is intended to afford the nonmoving party "an opportunity to cure any deficiency in that party's proof that may have been overlooked until called to the party's attention by a late motion for judgment." Rule 50(a)(2) advisory committee's note (1991 Amendment). Indeed,the courts have recognized that

> [w]hen a claimed deficiency in the evidence is called to the attention of the trial judge ad of counsel before the jury has commenced deliberations, counsel still may do whatever can be done to mend his case *But if the court and counsel learn of such a claim for the first time after verdict, both are ambushed and nothing can be done except by way of a complete new trial*. It is contrary to the spirit of our procedures to permit counsel to be sandbagged by such tactics or the trial court to be so put in error.

Quinn v. Southwest Wood Prods., Inc., 597 F.2d 1018, 1025 (5th Cir. 1979)

Thus, just as Judge Nies concluded, slip op. at 14-15, Lubrizol's failure to assert the new claim interpretation as a basis for its Rule 50 motions for JMOL precludes appellate review at this time of the sufficiency of the evidence with respect to that issue. *See Cone*, 330 U.S. at 217-18; *Sulmeyer v. Coca Cola Co.*, 515 F.2d 835, 846 (5th Cir. 1975), *cert. denied*, 424 U.S. 934 (1976); *Wang Lab., Inc. v. Toshiba Corp.*, 993 F.2d 858, 868-69, 26 USPQ2d 1767, 1777 (Fed. Cir. 1993); *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 858-62, 20 USPQ2d 1252,1259-61 (Fed. Cir. 1991), *cert. denied*, 504 U.S. 980 (1992).

None of the cases discussed by the majority supports its application of Rule 50. In *Boyle v. United Technologies Corp.*, 487 U.S. 500, 513 (1988) (slip op. at 10-11), the Supreme Court held that "[i]f the evidence presented in the first trial would not suffice, as a matter of law, to support a jury verdict under the properly formulated defense, judgment could properly be entered for the respondent at once, without a new trial." But in *Boyle*,

unlike this case, the "properly formulated defense" articulated by the court of appeals was substantively the same as that urged by the defendant in its Rule 50 motions. *See Boyle v. United Technologies Corp.*, 792 F.2d 413, 414 (4th Cir. 1986); "Memorandum of Law" filed in support of defendant's JNOV motion in *Boyle*.

In *Malta v. Schumerich Carillons, Inc.*, 952 F.2d 1320, 21 USPQ2d 1161 (Fed. Cir. 1991), *cert. denied*, 504 U.S. 974 (1992) (slip op. at 16-17 n.6), the pre-verdict motion put the plaintiff on notice that the defendant had challenged the sufficiency of the evidence of infringement under *all* theories, including the one relied upon by the Federal Circuit. Thus, this Court concluded that the legal "ground stated in support of the first motion for directed verdict and in support of the motion for JNOV *were one and the same*." 952 F.2d at 1325, 21 USPQ2d at 1164 (emphasis added). Here, in contrast, the broader interpretation of the claim rendered by this Court is not "one and the same" as the claim construction urged by Lubrizol.

Exxon, like the patent owner in *Orthokinetics Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986) (slip op. at 16-17 n.6), failed to object to Lubrizol's post-verdict motion for JMOL. But that motion was not objectionable; it challenged the sufficiency of the evidence supporting Exxon's claim of infringement based on only the claim interpretation Lubrizol proffered at trial and gave no inkling of the construction reached by the panel majority in this case.

In *all* of the other cases relied upon by the majority (slip op. at 14-15), this Court adopted the position urged by one of the parties at trial. *See Laitram Corp. v. Rexnord Inc.*, 939 F.2d 1533, 19 USPQ2d 1367 (Fed. Cir. 1991) (court adopted means-plus-function interpretation urged by accused infringer); *Jamesbury Corp. v. Litton Indus. Prods., Inc.*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985) (court adopted jury instruction urged by patent holder); *Dana Corp. v. IPC Ltd. Partnership*, 860 F.2d 415, 8 USPQ2d 1692 (Fed. Cir. 1988) (court adopted best mode defense urged by accused infringer), *cert. denied*, 490

U.S. 1067 (1989). Thus, no authority permits this Court to decide the question of infringement on appeal, while *sua sponte* announcing a new claim construction different from that urged at trial and depriving the losing party of an opportunity to prove infringement under that construction.

Moreover, this Court has recognized that "in general, an appellate court will only review a lower court's decision in light of the grounds and theories advanced below." *Bayer Aktiengesellschaft v. Duphar Int'l Research B.V.*, 738 F.2d 1237, 1243, 222 USPQ 649, 654 (Fed. Cir. 1984). "For this court to decide . . . unadjudicated and never-presented issues would be unfair to the district court, the parties, and the judicial process." *Black & Decker, Inc. v. Hoover Service Center*, 886 F.2d 1285, 1289, 12 USPQ2d 1250, 1254 (Fed. Cir. 1989). Thus, in a rare instance when it has decided a legal issue presented for the first time on appeal, this Court has considered it inappropriate to reverse and has instead vacated and remanded. *Bayer*, 738 F.2d at 1244, 222 USPQ at 654 ("No one, at trial, presented the full dimension" of the new issue); *see also Brinley v. Commissioner of Internal Revenue*, 782 F.2d 1326, 1336 (5th Cir. 1986) (justice requires that plaintiff be given the opportunity to present evidence on remand in light of new legal rule announced on appeal).

The majority's reversal and declaration that Lubrizol is entitled to JMOL, without a remand for consideration of a new trial motion on the Court's new claim construction, was clear error, striking at the heart of the relationship between appellate and district courts. This error goes far beyond the disposition of this case: Unless the panel majority's decision is modified, parties to future infringement suits will be forced to offer evidence regarding infringement, validity, and enforceability with respect to every conceivable claim construction — whether or not proffered at trial — leading to trials that are both a waste of judicial resources and confusing to judges and juries alike.

III. THE PANEL MAJORITY MISAPPLIED AND THEREBY UNDERMINED THIS COURT'S DECISION IN *MARKMAN* WHEN IT FAILED TO CONSIDER THE EXTRINSIC EVIDENCE RELIED UPON BY THE DISTRICT COURT'S DECISION REGARDING CLAIM CONSTRUCTION

Relying on *Markman*, the panel majority ruled that "claim interpretation is a matter of law," which "the trial judge alone has the duty and responsibility" to decide, as the district judge did in this case. Slip op. at 5. The Court then declared

> No matter when or how a judge performs the *Markman* task, on appeal we review the issue of claim interpretation independently without deference to the trial judge.

Id. The panel then proceeded to discuss only the claims, specification, and prosecution history in reversing the district judge's claim construction.

In so applying *Markman*, the panel majority wholly ignored its recognition that, because claims are to be construed from the perspective of one skilled in the art, it is frequently necessary for courts to consider extrinsic evidence, often in the form of testimony. 52 F.3d at 980-81, 34 USPQ2d at 1330-31. Thus, the panel majority construed the claims of Exxon's '890 patent without discussing the extrinsic evidence demonstrating that persons skilled in the art would have construed Exxon's patent as the district court did. See also *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 882, 8 USPQ2d 1468, 1471 (Fed. Cir. 1988) ("claims should be construed as one skilled in the art would construe them").

This action by the panel majority — treating as irrelevant extrinsic evidence regarding the perspective of a person skilled in the art to which the parties and the trials judge devoted much of the trial — is inconsistent with *SmithKline* and many other cases' recognition of the role of that evidence. Nothing in *Markman* requires, let alone justifies, this approach. To the contrary, a proper understanding of the role of extrinsic evidence and the "*de*

novo review" declared in that case for claim-construction issues, 52 F.3d at 979, 34 USPQ2d at 1329, can preserve *Markman's* essential holdings that claim construction raises a question of law for judges and that their determinations are to be reviewed *de novo*.

Justice Breyer, writing for a unanimous Court in *First Options of Chicago, Inc. v. Kaplan*, 115 S. Ct. 1920 (1995), recently clarified the meaning of "de novo" review. The issue before the Court was the standard of review that the Third Circuit should have applied when reviewing a district court decision that refused to vacate an arbitration award. Recognizing that the Third Circuit "sometimes used the word '*de novo*' to describe this standard" of review, *id.* at 1926, the Court nevertheless held that

> the reviewing attitude that a court of appeals takes toward a district court decision should depend upon 'the respective institutional advantages of trial and appellate courts,' not upon what standard of review will more likely produce a particular substantive result.

Id. (quoting *Salve Regina College v. Russell*, 499 U.S. 225, 231-233 (1991)).

Justice Breyer's opinion for the Court in *First Options* went on to make clear that even statutory construction issues, which obviously receive "*de novo*" review by appellate courts (see *Markman*, 52 F.3d at 987, 34 USPQ2d at 1336), do not always militate against giving some deference to the decision below. *See* 115 S. Ct. at 1926 (describing the "legal leeway" which courts give to administrative agencies' interpretations of statutes under *Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837 (1984)). *See also Silwany-Rodriguez v. Immigration & Naturalization Serv.*, 975 F.2d 1157, 1160 (5th Cir. 1992) (referring to the "limited," but nonetheless "*de novo* review" authority exercised by an appellate court in deferring to an agency's interpretation of a statute).

In light of these principles, the panel majority erred when it reached a claim construction different from the one articulated by

the trial judge, without even attempting to explain how its construction could be reconciled with the testimony of those skilled in the art discussed in Judge Nies's dissenting opinion. *Markman* recognizes that district courts have discretion to consider extrinsic evidence showing the perspective of one of ordinary skill in the art, and the district court that heard that evidence obviously had advantages, not available to the appellate court, in exploring those views.

In the circumstances of this case, like others in which testimonial extrinsic evidence is relied upon by the district court to interpret the claim, this Court's review should recognize the greater familiarity with that evidence possessed by the trial court, under the principles discussed by the Supreme Court in *First Options*. An appropriate appreciation of this aspect of this Court's *de novo* review authority with respect to claim construction would have led the Court to affirm the district court.

The trial judge found that "there was no dispute" (A1973) that "the hypothetical person skilled in the art to whom a patent is addressed," *Markman*, 52 F.3d at 986, 34USPQ2d at 1335, would read Exxon's claims, in the light of his own knowledge of lubricating oil concentrates and compositions, and conclude that the claims are drawn to a product resulting from the blending of the five specified ingredients no matter how they react with one another after blending. Thus, the witnesses for *both* parties, through their testimony and actions, demonstrated that the claims would have been interpreted by one of ordinary skill in the art as drawn to a product identified by its starting ingredients.

Dr. Colclough, one of the inventors of the '890 patent, stated that the claimed invention constitutes the composition of the specified starting ingredients, regardless of what occurs once they are blended. A575-76. Prosecuting attorney Johmann, based on his knowledge of "literally thousands of lubricant patents," agreed that the only relevant inquiry for purposes of determining infringement by Lubrizol's final product concerns examination of the ingredients used to make the product. A908-09; *see also* A1173-76. Dr. Salomon, *Lubrizol's own formulator*, testified that

the primary concern from a formulator's perspective is "what goes into the pot" and not what occurs in the pot after the ingredients are blended. A1496-97. Consistent with this, Lubrizol's 1985 validity opinion, 1988 infringement charts, and 1991 validity opinion all viewed Exxon's claims as specifying starting ingredients. A9506-19, 11296-308, 9520-44, A3-4 (damages).

Moreover, notwithstanding the panel majority's contrary conclusion, this extrinsic evidence is fully in accord with and supported by the specification and claims of the '890 patent. Thus, the specification instructed that "modern lubricants are complex *mixtures of various additives* each serving a particular purpose." A2532, Col. 1, line 67 to Col. 2, line 5 (emphasis added). The entire specification then discusses various conventional additives that can be used in the mixture, with the improvement of the '890 patent being, as the panel majority recognizes (slip op.at 4), the addition of a small amount of copper to the other typical additives. Furthermore, as Judge Nies's dissent explained, "the majority interpretation limits coverage to far fewer dispersants than indicated by the specification and claims." Slip op. at 7. This alone would dictate a conclusion that the claims encompass a composition identified by its starting ingredients. *See Smith v. Snow*, 294 U.S. 1, 14 (1935) ("if the claim were fairly susceptible of two constructions, that should be adopted which will secure to the patentee his actual invention").

The district court — properly under *Markman, SmithKline*, and numerous other cases — considered and weighed all of this evidence in construing Exxon's patent. The obvious impact of the majority's failure to consider that evidence will be to render the meaning of patent claims uncertain and to cause litigants to appeal in more patent cases. The outcome in the trial court will have less importance, and the decision in the Federal Circuit will depend to a large extent on the panel assigned and the extrinsic evidence, if any, it chooses to consider, defeating *Markmkan's* goal of "arriving at a true and consistent scope of the claims." 52 F.3d at 979, 34 USPQ2d at 1329.

The panel majority accordingly clearly erred when it reversed the district court's construction of the claim.

IV. CONCLUSION

The Petition for Rehearing and Suggestion for Rehearing *In Banc* should be granted.

Respectfully submitted,

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